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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Group: 1641

Confirmation No.:

Application No.: 09/848,967

Invention: IMMUNOGENIC PEPTIDES AND USES THEREOF

Applicant: Emanuel Calenoff and Charles Ditlow

Filed: May 4, 2001

Attorney

Docket: 21417/92378

Examiner: CHEU, CHANGHWA J

I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail No. EV 612996880 US in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on October 29, 2004

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THIRD SUPPLEMENTAL AMENDMENT TO
REQUEST FOR CONTINUED EXAMINATION FILED ON SEPTEMBER 24, 2004

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This amendment and response is filed in response to the Office Action mailed May 17, 2004, the Advisory Action mailed August 25, 2004, the Supplemental Advisory Action of September 14, 2004, and the Interview of October 12, 2004. The substance of the interview is incorporated herein.

Amendments to the Claims are reflected in the listing of the claims which begins on page 2 of this paper.

Remarks/Arguments begin on page 5 of this paper.

This listing of claims will replace all prior versions and listings of claims in the application.

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2d 281, 227 USPQ 657; *Ex parte Levingood, supra*. Both the suggestion to make the claimed composition or device or carry out the claimed process and the reasonable expectation of success must be founded in the prior art, not in applicant's disclosure. *In re Vaeck* (CAFC 1991) 947 F. 2d 488, 20 PQ. 2d 1438. The references, viewed by themselves and not in retrospect, must suggest doing what applicant has done. *In re Shaffer* (CCPA 1956) 229 F. 2d 476, 108 USPQ 326; *In re Skoll* (CCPA 1975) 523 F. 2d 1392, 187 USPQ 481.

In re Rouffet, the court held

"To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." *In re Rouffet*, 149 F.3d 1350 (Fed. Cir. 1998). (*emphasis added*).

Therefore, Claims 18-19, and 22 are not obvious over Regenmortel in view of either Hasegawa or Tu.

V. Figures are Illustrative Embodiments and Not Claimed

Embodiments in the figures are illustrative of how to apply the steps of claim 1. There are no specific peptides claimed as part of the invention, and case law clearly indicates that claims should not be limited to embodiments.

VI. Conclusion and Summary

In view of the arguments presented herein, please allow all pending claims.

No fees are believed due at this time, however, please charge any additional deficiencies or credit any overpayments to deposit account number 12-0913 with reference to our attorney docket number (21417/92378).

Respectfully submitted,



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October 29, 2004
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